

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No. 10/509,601
Attorney Docket No.: Q83766

AMENDMENTS TO THE DRAWINGS

Applicant is submitting herewith eleven (11) sheets of replacement Figures, which include FIGS. 1A-11C. FIGS. 11A-11C have been amended to include the label --Prior Art--. The remaining Figures are submitted herewith in order to obviate the Examiner's drawing objection.

The submitted Figures are intended to replace the Figures originally submitted on September 28, 2004.

Attachment: Eleven (11) Replacement Sheets

REMARKS

Claims 1-8 are all the claims pending in the Application. By this Amendment, Applicant editorially amends claims 1-3 for better conformity with the US practice and to cure minor informalities. In addition, Applicant adds claims 4-8. Claims 4-8 are clearly supported throughout the specification, *e.g.* pages 19-26 of the specification.

I. Preliminary Matters

The Examiner has acknowledged Applicant's claim to priority and has indicated receipt of the certified copy of the Priority Document. The Examiner has returned the initialed form PTO/SB/08 submitted with the Information Disclosure Statement filed on September 28, 2004.

The drawings filed on September 28, 2004 have been objected to by the Examiner. Specifically, the copy of the drawings filed with the application is not of good quality. Further, the Examiner has indicated that FIGS 11A to 11C should be designated with a legend --Prior Art-- (*see* page 2 of the Office Action). Applicant submits herewith a new set of drawings of better quality and labeling FIGS 11A to 11C "Prior Art".

II. Summary of the Office Action

Claims 1 and 3 are objected to because of minor informalities. Claim 2 is rejected under 35 U.S.C. § 112, second paragraph and claims 1-3 are rejected under 35 U.S.C. § 102(b).

III. Claim Objections

Claims 1 and 3 are objected to because of informalities. Applicant respectfully requests the Examiner to withdraw these objections in view of the self-explanatory claim amendments made herewith.

IV. Claim Rejections under 35 U.S.C. § 112

Claim 2 is rejected under 35 U.S.C. § 112, second paragraph. Applicant respectfully requests the Examiner to withdraw this rejection of claim 2 in view of these self-explanatory claim amendments being made herewith.

V. Claim Rejections under 35 U.S.C. § 102

Claims 1-3 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,019,470 to Mukaiyama (hereinafter “Mukaiyama”). Applicant respectfully traverses these grounds of rejection in view of the following comments.

The Examiner contends that Mukaiyama discloses each feature of independent claim 1. This rejection is not supportable for at least the following reasons. The first expression set forth in claim 1 **cannot be mathematically derived** from the expression in col. 6, lines 60 to 65 of Mukaiyama. Mukaiyama’s expression set forth in col. 6, lines 60 to 65 is a simpler calculation that combines the toric surface with the assumption that the c_x and c_y are fixed. That is, Mukaiyama fails to account for all kinds of shapes of the toric surface. In other words, Mukaiyama’s expression lacks flexibility of the first expression set forth in claim 1 (*see e.g.*, pages 5-6 of the specification).

If the Examiner maintains that the first expression set forth in claim 1 may be derived from the expression in col. 6, lines 60 to 65 of Mukaiyama, it is respectfully requested that the Examiner provide **a mathematical proof** deriving the first expression set forth in claim 1 from the expression in col. 6, lines 60 to 65 of Mukaiyama. “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d

1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131. The Examiner's conclusory statement that one equation can be derived from another is not a showing that meets the burden set forth in 35 U.S.C. § 102.

In addition, Mukaiyama's expression only combines the toric surface with the assumption that the curvature in the x-axis direction and the curvature in the y-axis direction are each fixed (*e.g.*, ¶ 4 of the specification). That is, Mukaiyama fails to disclose or suggest a combined refracting interface composed of the progressive refracting interface and the toric surface which has more excellent astigmatism corrective power (*e.g.*, ¶ 5 of the specification).

Furthermore, the first expression set forth in claim 1 may achieve the astigmatism correction that considers ocular motility correction, whereas the above-mentioned Mukaiyama's expression does not take into consideration ocular motility correction. The second expression set forth in claim 1 is simpler than above-mentioned Mukaiyama's expression. Therefore, the program creation of the calculation processing is easy. Because the calculation can be simplified by installing two square roots in the expression. When the square root calculates only by one, the calculation processing is complicated.

In summary, the deficiencies of the Mukaiyama reference fall to the Examiner's burden to show inherent inclusion of the claim elements. Therefore, for all the above reasons, independent claim 1 is patentable. Claim 2 is patentable at least by virtue of its dependency on claim 1.

With respect to claim 3, it recites limitations similar to, although not coextensive with, the limitations argued above with respect to claim 1. Since claim 3 contains features that are

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similar to the features argued above with respect to claim 1, those arguments are respectfully submitted to apply with equal force here. For at least substantially analogous reasons, claim 3 is patentably distinguishable from Mukaiyama.

VI. New Claims


In order to provide more varied protection, Applicant adds claims 4-8. Claims 4-8 are patentable at least by virtue of their dependency on claims 1 and 3.

VII. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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